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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,438	09/26/2003	Tetsuya Yamamura	0305369	5065

7590 05/26/2006

Intellectual Property Department
Mayer Brown Rowe & Maw LLP
1909 K Street NW
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EXAMINER	
MCCLENDON, SANZA L	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/671,438	YAMAMURA ET AL.	
	Examiner	Art Unit	
	Sanza L. McClendon	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-25 and 54-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-25 and 54-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 08/989,407.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In response to the Amendment received on April 26, 2006, the examiner has carefully considered the amendments. The examiner acknowledges the cancellation of claims 1-13, 15-20, 26-53 and 59-67.

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Response to Arguments

3. Applicant's arguments, see Amendments/Remarks, filed April 26, 2006, with respect to the rejection(s) of claim(s) 1, 3-8, 10-11, 13, 27, 30, 33, 36, 39, 42, 45, and 48 under 35 USC 103(a) as being unpatentable over Chikaoka et al (WO 96/35,3756 have been fully considered and are persuasive, and therefore, the rejection has been withdrawn. Likewise, the rejection of claims 1-13, 15-20, 26-53 and 59-65 under 35 USC 103(a) as being unpatentable over Chikaoka et al in view of Igarashi et al (5,674,922) as evidenced by Ohkawa et al (5,434,196) has been withdrawn.

4. However, upon further consideration, obviousness-type double rejections are deemed warranted—see below.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 21-25 and 54-58 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 7-9 of U.S. Patent No. 6,365,644. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to comprise overlapping subject matter. The difference between the instant claimed process and said patented process is said patent broadly discloses the use of oxetane compounds in said process, which includes the instantly claimed oxetanes having 2, 3,or more oxetane rings used in the instantly claimed process. Additional, support that said oxetanes of 5,365,644 includes the instantly claimed oxetane compounds can be found in the disclosure of 6,365,644 in column 3, lines 30-34 and column 5, lines 25-63. Another difference between processes is the broadly disclosed epoxy compounds in the instant application, however these encompass epoxy compounds found in the Markush grouping 6,3565,644. Therefore, one of ordinary skill in the art would be able to use/obtain the process as instantly claimed from 6,365,644. The difference between the instantly claimed composition and the composition of 6,365,644 is the absence of the polyfunctional monomer as found in the Markush grouping. However, as evidenced by the disclosure of 6,365,644 the composition of claim 1 can additionally comprises polyfunctional monomer—see column 14, lines 60-65. Therefore an artisan of ordinary skill level could use/make the composition as instantly claimed from 6,365,644.

7. Claims 21-25 and 54-58 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 9, and 14-15 of U.S. Patent No. 5,981,616. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to comprise overlapping subject matter. The difference between the two compositions is the absence of the polyfunctional monomer as found in the Markush grouping of the instant claims and the oxetanes having 2,3, or more oxetane rings in 5,981,616. However, per claim 9 of 5,981,616, a ethylenically unsaturated

compound can be added to said composition, which as supported by the disclosure can be a polyfunctional acrylate monomer, such as those found in the instant claims—column 4, lines 60-65. The broad teaching of oxetane in the claims of 5,981,616 encompasses oxetanes having 2, 3, or more oxetane rings, and additional support that these are encompasses in said broad teaching can be found in column 3, lines 24-27 and columns 4-5 and 7. Therefore an artisan of ordinary skill level could use/make the composition as instantly claimed from 5,981,616. The process of 5,981,616 and the instant process differ for the same reasons as seen above; therefore it would have obvious for an artisan of ordinary skill level to use/obtain the instantly claimed process from 5,981,616.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Japanese document 08/085775 to Niwa et al discloses a similar composition. Japan document 08-208832 to Niwa et al discloses a cationic photopolymerizable composition that contains oxetanes and epoxides. Japan document) 8-218296 to Niwa et al discloses a photopolymerizable composition that comprises a compound with 1-4 oxetane rings, an epoxy compound and a cationic photoinitiator. Japan document 08-277385 to Niwa that discloses a similar photocurable composition. The differences between these applications to Niwa et al and this application is Niwa et al does not expressly disclose the use of hexa- and penta-functional acrylate monomers. Niwa et al discloses the use of acrylates having up to 4 acrylate groups.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sanza L McClendon 5/3/06
Examiner
Art Unit 1711

SMc